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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,399	01/23/2004	Guadalupe C. Garcia	GCG-102/CIP	4566

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LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
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EXAMINER	
REIS, TRAVIS M	

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,399	GARCIA, GUADALUPE C.	
	Examiner	Art Unit	
	Travis M. Reis	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-45 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-45 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 23 January 2004 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 5-10-04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 6, 11-13, 22, 26, & 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7-9, 11, & 13 of U.S. Patent No. 6766760. Although the conflicting claims are not identical, they are not patentably distinct from each other because the language of the claims of the present application encompass the limitations of the claims in Patent 6766760 (i.e. a base for stacking, a coil/flexible means having an impulse response, and a cover). Though the claims of Patent 6766760 more exactly specify the features of the invention, the claims meet the limitations of the application.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "112" has been used to designate both opening and round edges. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 210, 660. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The use of the trademark 3M has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The disclosure is objected to because of the following informalities:

On page 12, line 6, "510" should be ---520---, to match the figures.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-7, 9-11, 13-23, 25, & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwok (U.S. Patent 5488792) in view of Barnard (U.S. Patent 4256050).

With reference to claims 1, 4-7, 10, 13, 18-23, 26, Kwok discloses a safety cone comprising a square base (4); and a flexible coil/rod (2) broadly considered to have an fast impulse response to indirect and direct perturbations, since any perturbation will incur some sort of instant corresponding response (i.e. there is no delayed response when touched) positioned over said base wherein a bottom part of said coil is attached to said base, wherein said coil is shaped as a cone with 10 loops with the bottom loops having a larger diameter than the opening, said coil positioned over said base, and said base supports the flexible means, a cover (11) to cover said flexible means, wherein said cover is made of a meshed flexible material with a reflective band (1) (Figure 1) and allows said fast impulse response to said direct and indirect perturbations; and wherein said flexible means and said cover are modular components (Figure 3) which are combined by means of a quick-connector (33) and wherein said coil maintains in an original position in absence of a perturbation, said coil deviates from said original position to a new position in presence of said perturbation, and said coil restores from said deviated position back to said original position after said perturbation disappears or is removed; a reflective flexible cover (1) (Figure 4A) (col. 2 lines

7-10) to cover said flexible coil; and securing means (42) for temporarily secure said base to a surface (Figure 3).

Kwok does not disclose an opening in said base to allow for stacking of a plurality of safety cones.

Barnard discloses a collapsible marker cone (4) with a base (1) with an aperture (2) (Figure 3) (col. 3 line 64), wherein when said strip is extended allows for stacking of a plurality of safety cones. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the aperture disclosed by Barnard to the base disclosed by Kwok in order that a plurality of safety cones could be stacked easily stored together without having to spend time collapsing and storing the cones.

With reference to claims 2, 3, & 14-17, Kwok discloses the loops of said coil maintain space from each other during said perturbations.

Kwok does not disclose said perturbations allow deflections ranging from 15 degrees to about 180 degrees. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a coil having deflections ranging from 15 to 180 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the "optimum range" involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to have the coil range from 15 to 180 degrees in order to be more aesthetically attention-getting to persons nearby in need of warning.

With reference to claims 9 & 25, Kwok does not disclose the reflective material is 3M 8710 reflective material. However, the particular type of material used to make the reflective material, absent any criticality, is only considered to be the use of a " preferred " or " optimum " material out of a plurality of well known materials that a person having ordinary skill in the

art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus, and since the courts have stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. See In re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to use 3M 8710 reflective material in order to obtain reflective material simply.

9. Claims 8 & 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwok & Barnard as applied to claims 1-7, 9-11, 13-24, & 26 above, and further in view of Ahn (U.S. Patent 5888016).

Kwok & Barnard disclose all of the instant claimed invention as stated above in the rejection of claims 1-7, 9-11, 13-24, & 26 but do not disclose two reflective bands wherein the first reflective band is positioned at about 3" from the top of said cover and said first band is about 6" in height, and wherein the second reflective band is positioned at about 2" from the bottom of said first reflective band and said second band is about 4" in height.

Ahn discloses a self recovering traffic collar cone (1) with two reflective bands (27) wherein the first reflective band is positioned at about 3" from the top of said cover and said first band is about 6" in height, and wherein the second reflective band is positioned at about 2" from the bottom of said first reflective band and said second band is about 4" in height (Figure 2). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the second band disclosed by Ahn below the first band disclosed by Kwok & Barnard in order to increase the visibility of the cone.

10. Claims 12, 27-39, & 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwok & Barnard as applied to claims 1-7, 9-11, 13-24, & 26 above, and further in view of

Johnson (U.S. Patent 6119621).

Kwok & Barnard disclose all of the instant claimed invention as stated above in the rejection of claims 1-7, 9-11, 13-24, & 26 but do not disclose two or more flexible means in a fence-like shape.

Johnson discloses a barrier (12) and modular cone (10) with multiple flexible means (30a, 30b, 30c) for increasing the flexibility and versatility of the cone (Figure 4), as shown in the embodiment of Figure 10 of a fence. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add multiple flexible means as taught by Johnson to the device disclosed by Kwok & Barnard in order to increase the flexibility and versatility of the device.

With reference to claims 12, 27, & 44, Kwok & Barnard disclose all of the instant claimed invention as stated above in the rejection of claims 12, 27-39, & 41-45 but do not disclose a light source attached to said base and a sensor to operate said light source.

Johnson discloses, in the embodiment of Figure 9, said cone has a light source (56) (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the light source disclosed by Johnson to the cone disclosed by Kwok & Barnard in order to increase the visibility of the cone.

11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kwok, Bernard, & Johnson as applied to claims 28-39 & 41-45 above, and further in view of Ahn.

Kwok, Bernard, & Johnson disclose all of the instant claimed invention as stated above in the rejection of claims 12, 27-39, & 41-45, but do not disclose two reflective bands wherein the first reflective band is positioned at about 3" from the top of said cover and said first band is about 6" in height, and wherein the second reflective band is positioned at about 2" from the bottom of said first reflective band and said second band is about 4" in height.

Ahn discloses a self recovering traffic collar cone (1) with two reflective bands (27) wherein the first reflective band is positioned at about 3" from the top of said cover and said first band is about 6" in height, and wherein the second reflective band is positioned at about 2" from the bottom of said first reflective band and said second band is about 4" in height (Figure 2). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the second band disclosed by Ahn below the first band disclosed by Kwok, Bernard, & Johnson in order to increase the visibility of the cone.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wright discloses a warning marker (U.S. Patent 3596628). Grundvig et al. discloses a road marker (U.S. Patent 3851615). Goellner discloses a slalom pole (U.S. Patent 4588324). Johson discloses a folding warning marker (U.S. Patent 5199375). Ho discloses a telescopic roadblock. (U.S. Patent 6338311).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M. Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis
Examiner
Art Unit 2859

tmr
March 8, 2005

Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

CHRISTOPHER W. FULTON
PRIMARY EXAMINER